

REMARKS

The enclosed is responsive to the Examiner's Office Action mailed on October 30, 2008. At the time the Examiner mailed the Office Action claims 8-22, were pending. By way of the present response Applicants have: 1) amended no claims; and 2) added no claims; and 3) canceled no claims. As such, claims 8-22 are now pending.

Applicants respectfully request reconsideration of the present application and allowance of all claims now presented.

Claim Rejections – 35 U.S.C. § 101

The Examiner rejected claims 13-17 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The rejection asserts that since the claims are directed to a computer readable storage medium and the specification is asserted to describe a computer readable storage medium as possibly including “a carrier wave” and “transmission over the internet” terms, then it is asserted that the entire claim is non-statutory. The rejection asserts that the conclusion that these are non-statutory and cannot be claimed has been “well established.”

Applicant traverses the rejection and assert that the rejection fails to provide any legal support for the conclusions it draws upon, and thus, also fails to make much of a prima facie case based on any evidence. Applicant requests that the Examiner provide clear support for the legal conclusions upon which the rejection is based.

The rejection raises a number of major issues of law that are both unsupported and incorrect. For example, it is incorrect to reject a claim if a claim covers some embodiments that are statutory subject matter and some embodiments that are non-statutory. Applicant asserts that it is only when the claim has no statutory subject matter can the claim be properly

rejected. The burden of proof is upon the Examiner to make a prima facie case, and thus, to provide legal support for the assertions made in the rejection.

Another issues raised by Applicant is that the rejection appears to be asserting that it is “well established” that anything related to a “carrier wave”, etc. must be non-statutory. Applicant is uncertain if the Examiner is taking “Official Notice” on case law, but in any event, Applicant requests that the rejection provide full support with the relevant case law. Applicants are unaware of such a blanket ruling. Case law that did involve such terms involved certain special tests, which do not appear to be at all relevant to the claims at issue. The burden of proof is upon the Examiner to make a prima facie case, and thus, to provide legal support for the assertions made in the rejection.

Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 13-17 under 35 U.S.C. § 101.

Claim Rejections – 35 U.S.C. § 103

The Examiner rejected claims 8-22 under 35 U.S.C. § 103(a) as being unpatentable over Rambaldi et al. (US 6,618,084) (hereinafter, “Rambaldi”) in view of Mori et al. (US 5,168,379) (hereinafter, “Mori”) in further view of Dalton et al. (US 5,493,332) (hereinafter, “Dalton”). The rejection asserts that Applicant’s arguments are moot in view of the new grounds of rejection. However, the previous rejection was based on the combination of Rambaldi and Mori, and the new rejection merely added Dalton, while merely repeating the previous rejection based on Rambaldi and Mori. Applicant’s arguments identified the deficiencies in Rambaldi and Mori, which are relevant to Dalton and the currently repeated rejection and would make evident the failings of Dalton.

Dalton is introduced to allegedly disclose the use of an identifier representing “**identification data** for use identifying specific image capturing device from which the **image has been captured.**” However, Dalton fails to remedy the deficiencies of Rambaldi and Mori at least in part due to failure to disclose all the limitations of claim 8, and that Dalton teaches away from claim 8.

Claim 8 relates to capturing an image with said image capturing device, wherein the identifier comprises encoded sensor identification data for use in **identifying the specific sensor** from which the image had been captured; processing said image such that said identifier is decoded from said image to produce sensor identification data; and **storing** said sensor identification data with said image. In contrast, Dalton’s alleged disclosure of identification data is not encoded nor is it used for identifying a specific sensor nor is it stored with the image. In fact, the term “identification data” in Dalton actually refers to operating parameters of the plurality of sensors so that the sensors can be replaced and still use the same operating parameters. See column 5, lines 44-50. This clearly teaches away from claim 8 because the replacement sensors, of which there are many, have and use the same operating parameters or identification data, so the identification data in Dalton is not unique, and thus, cannot be used to identify which image was recorded on which specific sensor. Note also that the operating parameters in Dalton are stored in an EEPROM memory device (28) in the camera head (11), which makes it easy to change, unlike a deliberate permanent destruction of pixels.

Applicant has reiterated the previously presented arguments to the same combination of Rambaldi and Mori again presented and relied upon in the Final rejection. Applicant respectfully requests that the Examiner respond to all of the arguments presented.

Claim 8 relates to a **method of tracking images**, said method comprising: placing an image sensor in a image capturing device, said image sensor having a plurality of intentionally modified transistors that form an identifier; capturing an image with said image capturing device, wherein the identifier comprises **encoded sensor identification data** for use in **identifying** the specific sensor from which the image had been captured; processing said image such that said identifier is **decoded** from said image **to produce sensor identification data**; and storing said sensor identification data with said image.

In contrast, neither Rambaldi nor Mori disclose or suggest a **method of tracking images**, nor an **encoded sensor identification data** for use in **identifying** the **specific sensor**; nor **decoded** from said image **to produce sensor identification data**. Rambaldi appears to be related to **identifying manufacturing defects** in the sensor and then correcting the defects by interpolation from adjacent pixels. The defects are not intentional, nor are they used for **identification purposes** of the sensor, nor are they **encoded or decoded** to provide such **identification** of the sensor. Mori suffers from similar defects and appears to relate to intentionally creating a **location mark** in the sensor, which is **not** at all related to the **identification of the sensor**. In fact Mori appears to teach away from the claimed invention because Mori is directed to providing timing data that changes with time and the images captured, whereas claim 8 requires that sensor be permanently modified with an encoded identifier, which does not change, and is embedded in the data files of each image captured. There is **no encoding nor decoding**, nor any mechanism to provide any **identification data** in either prior art references of record.

Furthermore, claim 13 relates to similar features discussed above, in addition to the feature requiring that the identification features serve to deter the capability of fraudulently modifying the sensor identification data by users. Again the prior art of record fails to

disclose or suggest any identification features of the sensor, and Mori actually teaches away from the invention because it provides a user controlled time stamp. Further, the location mark in Mori does not provide any uniqueness that would permit one to distinguish or identify one sensor over other similar sensors.

In view of the above remarks, a specific discussion of the dependent claims is considered to be unnecessary. Therefore, Applicants' silence regarding any dependent claim is not to be interpreted as agreement with, or acquiescence to, the rejection of such claim or as waiving any argument regarding that claim.

Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 8-22 under 35 U.S.C. § 103(a) as being unpatentable over Rambaldi in view of Mori.

CONCLUSION

Applicant respectfully submits that the present application is in condition for allowance. Applicant's Representative would like to request withdrawal of the Final Rejection and if necessary to place the application in condition for allowance, a telephone conference with the Examiner. The Examiner is requested to call Neal Berezny at (408) 962-7563 to schedule a telephone conference.

Pursuant to 37 C.F.R. 1.136(a)(3), applicant(s) hereby request and authorize the U.S. Patent and Trademark Office to (1) treat any concurrent or future reply that requires a petition for extension of time as incorporating a petition for extension of time for the appropriate length of time and (2) charge all required fees, including extension of time fees and fees under 37 C.F.R. 1.16 and 1.17, to Deposit Account No. 02-2666.

Respectfully submitted,

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